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In re Application of :
NAKANO et al. :
U.S. Application No. 09/856,402 :
PCT No.: PCT/JP00/07229 :
Int. Filing Date: 18 October 2000 : DECISION ON PETITION
Priority Date: 18 October 1999 :
Attorney Docket No.: EHAR0010 :
For: POLISHING MACHINE FOR :
PERIPHERAL EDGE OF :
SEMICONDUCTOR :

This is in response to applicants' "Renewed Petition Under 37 CFR 1.182" filed 04 March 2003 which is being treated as a Renewed Petition under 37 CFR 1.47(a). No petition fee is required.

BACKGROUND

On 18 October 2000, applicants filed international application PCT/JP00/07229 which claimed a priority date of 18 October 1999 and designated the United States. The international application listed Yoshiyuki Nakano; Yasuhir Kosawa; and Hitoshi Tambo as applicant/inventors. A Demand for international preliminary examination was not filed prior to the expiration of nineteen months from the international filing date. Accordingly, the twenty-month period for paying the basic national fee in the United States was midnight, 18 June 2001.

On 21 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; and a preliminary amendment.

On 21 June 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 12 October 2001, applicants filed petition under 37 CFR 1.47(a). The petition was dismissed without prejudice in a decision dated 05 February 2002.

On 07 June 2002, applicants filed renewed petition under 37 CFR 1.47(a). The petition was dismissed in decision dated 04 September 2002 because the declaration was defective pursuant to 37 CFR 1.497.

On 24 September 2002, applicants filed the renewed petition under 37 CFR 1.47(a). The renewed petition under 37 CFR 1.47(a) was not a proper response to the Decision mailed 04 September 2002.

On 03 March 2003, applicant filed the present petition which was accompanied by: Statement of Teruyuki Nakano; Statement of Kunihiro Shiromura; Communication in Cases for Which No Other Form is Applicable (PCT/IB/354); and petition fee for a four-month extension of time (\$725). The extension of time fee was charged to Deposit Account no. 50-0710.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. The 04 September 2002 decision indicated that petitioner had satisfied items (1), (2) and (3) above.

As to item (4), the decision dated 04 September 2002 and 10 December 2002 indicated that the declaration filed 12 October 2001 was defective pursuant to 37 CFR 1.497. Specifically, the declaration had been executed by "Teruyuki" Nakano whereas the international application lists "Yoshiyuki" Nakano as the first inventor. In response to the Decision, applicants filed the present petition which included, inter alia: Statement of Teruyuki Nakano; Statement of Kunihiro Shiromura; and Communication in Cases for Which No Other Form is Applicable (PCT/IB/354). The Communication in Cases for Which No Other Form is Applicable (PCT/IB/354) states, "[t]he International Bureau will re-issue the front page of the pamphlet on 27 February 2003 due to error to the Applicant and Inventor's name. Under (72,75) replace "Nakano, Yoshiyuki" by "Nakano, Teruyuki" and "Kosawa Yasuhiro" by "Kozawa Yusuhiro." Therefore, the papers filed on 03 March 2003 have been reviewed and are accepted.

The declaration submitted on 12 October 2001 and executed by: Teruyuki Nakano and Yasuhiro Kozawa; and on behalf of nonsigning inventor, Hitoshi Tambo is accepted.

CONCLUSION

For the reasons discussed above, applicants Renewed Petition under 37 CFR 1.47(a) is GRANTED.

A review of the application papers reveals that applicant completed all the requirements of 35 U.S.C. 371 for entry into the national stage. This application will be given an international application filing date of 18 October 2000 and a date of **12 October 2001** under 35 U.S.C. 371.

The application is being returned to the United States Designated/Elected Office for further processing in accordance with this decision.



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